

Customer No. 31,834

Attorney Docket No. BR029-US-02

REMARKS

Claims 1-52 are now pending in this application. Claims 1-46 were pending in this application. Claims 18-20 and 46 have been amended to more particularly specify the invention. Claims 47-52 have been added. Support for the amendments and new claims is found throughout the specification, particularly in original claims 8, 19 and 14.

The Examiner has required restriction of claims 1-46 under 35 U.S.C. § 121. More specifically, the Examiner has required restriction to one of four (4) groups, as described below:

Group I - claims 1-15
Group II - claims 16-32
Group III - claims 33-41
Group IV - claims 42-46

Furthermore, the Examiner has required that a species be elected pursuant to 35 U.S.C. § 121. Specifically, the Examiner has requested that the elected species name a particular gas, film-forming surfactant and any additional components of the dried material.

Applicants elect, with traverse, the claims of Group II (claims 16-32) and the species in which the film-forming surfactant comprises a phospholipid, preferably DSPC, the dried material further comprises PEG or a sugar, and the gas which has a pressure lower than atmospheric comprises perfluorobutane. Applicants respectfully submit that new claims 47-52, which depend from claims within Group II, should be included in Group II. Furthermore, in Group II, claims 16-32 and 47-52 read on the elected species.

Applicants respectfully maintain that the claims of Groups I-IV (and the species included therein) could be searched together without undue burden. As an initial matter, Applicants note that contrary to the Examiner's description of Group II, claims 16-17, 21-23 and 32 do not

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require a container and dependent claims 18-20 have been amended to delete this language. Thus, Group II includes a composition comprising a dried material comprising at least one film-forming surfactant and a gas with a pressure lower than atmospheric pressure. Similarly, each of the other groups requires a dried material comprising at least one film forming surfactant and a gas, which prior to reconstitution, has a pressure lower than atmospheric pressure. Thus, searching the claims of these Groups should not be burdensome. Applicants note that MPEP § 808.02 states that even if related inventions are shown to be distinct, the Examiner must also show serious burden "by appropriate explanation."

Moreover, as a result of the GATT legislation limiting the term of a patent to twenty years from its effective filing date, the delay in the examination of the non-elected claims will likely result in the patent term for these claims being unnecessarily shortened.

Furthermore, it is likely that the same Examiner would be in charge of the divisional application; but since that divisional application will be examined at a much later date, the Examiner will have to conduct a duplicate, redundant search at the time she examines the divisional application. Alternatively, if a different Examiner is assigned to the divisional application, a significant loss of PTO efficiency would be incurred as a result of the examination of that divisional case.

In view of the foregoing, withdrawal of the requirements for restriction/election is respectfully requested.

Applicants note that they were somewhat confused by the Examiner's statements regarding Groups I and II in paragraph 1 and would like to clarify that Group I is a final product, a contrast agent, and Group II is an intermediate composition useful in the preparation of a contrast agent. Thus Examiner's statement that "the intermediate product is deemed to be useful as a composition used as an embolizing agent for a tumor" is not understood.

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